

### REMARKS

Applicant is submitting herewith a Supplemental Information Disclosure Statement.

Also, Applicant notes that an Information Disclosure Statement dated February 5, 2003 has not been indicated by the Examiner as being considered. A copy of the Information Disclosure Statement dated February 5, 2003 is attached, where the Information Disclosure Statement includes the OIPE date stamp indicating receipt of the Information Disclosure Statement on February 5, 2003, by the U.S. Patent Office. It is respectfully requested that the Examiner place his initials in the PTO-1449 Form by the references cited in the February 3, 2003 Information Disclosure Statement.

In the Office Action dated January 8, 2007, claims 1, 3-9, and 12-32 were rejected under 35 U.S.C. § 103 over U.S. Patent No. 6,894,994 (Grob) in view of U.S. Patent Application Publication No. 2002/0057653 (Dolan).

Independent claim 1 was rejected as being obvious over the asserted combination of Grob and Dolan. It is respectfully submitted that a *prima facie* case of obviousness has not been established with respect to claim 1 over the asserted combination of Grob and Dolan, for at least the following reason: no motivation or suggestion existed to combine the teachings of the references. *See* M.P.E.P. § 2143 (8<sup>th</sup> ed., Rev. 5), at 2100-126.

With respect to claim 1, the Office Action conceded that Grob fails to disclose the following elements of claim 1: in response to determining that handoff is required, sending a message from the first base station to the second base station, the message indicating to the second base station that handoff is required. 1/8/2007 Office Action at 2. The Office Action, however, relied upon Dolan as disclosing this claim element. *Id.* Specifically, the Office Action pointed to Fig. 6 of Dolan, which shows a source base station sending a source transfer request to an MSC, which in turn forwards the source transfer request to a target base station, for the purpose of performing a handoff.

It is respectfully submitted that a person of ordinary skill in the art would not have been motivated to modify the handoff mechanism taught by Grob with the mechanism disclosed by Dolan to achieve the claimed subject matter. Although Grob states that handoffs between CDMA and HDR systems are possible, the handoff performed in Grob is quite different from the handoff performed according to claim 1. As discussed in Grob, when an access terminal 110 is near an edge of the coverage area of an HDR access point 120, the access point 120 can signal

the access terminal 110. Grob, 24:27-29. This causes the access terminal 110 to search for both an HDR system access point 120 and CDMA base station. Grob, 24:29-32. If a CDMA pilot is detected by the access terminal 110, then the air link can be handed from the HDR system to the CDMA system, "for example, in a manner similar to the handoff between IS-95 and AMP systems." Grob, 24:32-35.

Thus, what is contemplated by Grob is that a base station of a first type has to notify the access terminal (not the base station of the other type) that handoff may be required, which causes the access terminal to search for available HDR and CDMA base stations. Clearly, Grob does not disclose or suggest base stations of different types sending a message between each other to indicate that handoff is required.

Recognizing this deficiency of Grob, the Office Action turned to Dolan in an attempt to address the deficiencies of Grob. As purported support for the combination of Grob and Dolan, the Office Action stated that the "motivation for combining this teaching is that it allows for reaching an agreement of the handoff type before the handoff procedure is commenced (Dolan, paragraph 41)." 1/8/2007 Office Action at 3. The stated motivation for combining Grob and Dolan is inapplicable, since Grob does not contemplate any desirability to incorporate a feature where two base stations have to communicate with each other for the purpose of determining a "handoff type before the handoff procedure is commenced." As discussed above, Grob contemplates that a base station of a first type has to notify the access terminal (*not the base station of the other type*) that handoff may be required, which causes the access terminal to search for available HDR and CDMA base stations. Clearly, Grob does not suggest any desirability to perform inter-base station communications for the purpose of "reaching an agreement of the handoff type," as suggested by the Office Action.

Effectively, the Office Action has been unable to find any rationale or suggestion, whether implicit or explicit, in the objective evidence of record which would have indicated that a person of ordinary skill in the art would have been motivated to modify the teachings of Grob based on the teachings of Dolan. Instead, the Office Action has relied on impermissible hindsight to piece together the teachings of the references. *See In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988) ("One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.").

The objective evidence of record actually indicates that a person of ordinary skill in the art would not have been motivated to modify Grob based on the teachings of Dolan. The Office Action is proposing a modification of the Grob handoff mechanism that would significantly change the principle of operation of the Grob. "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." M.P.E.P. § 2143.02, at 2100-130. Here, as noted above, the handoff mechanism disclosed by Grob involves a base station of a first type notifying an access terminal (not the base station of the other type) that handoff may be required, which causes the access terminal to search for available HDR and CDMA base stations. Modifying the Grob system based on the teachings of Dolan would significantly change the principle of operation of the handoff mechanism of Grob, which is a clear indication that no motivation or suggestion existed to combine Grob and Dolan.

In view of the foregoing, it is respectfully submitted that a *prima facie* case of obviousness has not been established with respect to claim 1.

Independent claims 16 and 24 are allowable for similar reasons.

Dependent claims are allowable for at least the same reasons as corresponding independent claims.

In view of the foregoing, it is respectfully requested that the final rejections of the claims be withdrawn. The Commissioner is authorized to charge any additional fees and/or credit any overpayment to Deposit Account No. 20-1504 (NRT.0103US).

Respectfully submitted,

Date: \_\_\_\_\_

Apr. 9, 2007



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